

**REMARKS**

**Request for Withdrawal of Finality of Office Action**

While the Office Action Summary indicates that this action is final and the Examiner indicates on the bottom of page 5 of the Office Action that Applicant's amendment necessitated the new ground(s) of rejection, Applicants submit that the finality is not appropriate because the Office Action contains a new ground of rejection **not** necessitated by Applicant's amendment. In particular, the rejection of claim 15 under 35 U.S.C. 112 clearly was not necessitated by Applicant's amendment, since claim 15 was not even amended in the last Amendment. Also, Applicants note that the outstanding Office Action contains new grounds of rejection based on newly cited art.

In view of the above, Applicants submit that the finality of the Office Action is improper, and thus withdrawal of the finality of the Office Action is respectfully requested.

**PTO/SB/08 Form filed September 2, 2004**

Applicants note that the Examiner has not provided a copy of the September 2, 2004 PTO/SB/08 form with the WO 98/51679 citation initialed, despite Applicants' request at pages 5-7 of the Amendment filed April 11, 2008. Accordingly, Applicants refer the Examiner to that discussion, and request that the Examiner provide a copy of the September 2, 2004 PTO/SB/08 form with the WO 98/51679 citation initialed in the next communication from the PTO.

**Rejection under 35 U.S.C. 112, Second Paragraph**

On page 2 of the Office Action, claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

### **The Examiner's Position**

The Examiner indicates that claim 15 provides for a method, but it is unclear what method/process applicant is intending to encompass, since the claim does not set forth any steps involved in the method/process. In this regard, the Examiner indicates that a claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

### **Applicants' Response**

In response, Applicants have amended claim 15 as set forth above to recite active, positive step, namely, a step of applying an effective amount of the whitening cosmetic composition according to any of claims 2, 3, and 7-14 to the skin.

Thus, Applicants submit that claim 15 satisfies the requirements of 35 U.S.C. 112, second paragraph, and withdrawal of this rejection is respectfully requested.

### **Anticipation Rejection over Kato**

On page 3 of the Office Action, claim 2, 3, 7, 8 and 11-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Kato et al., US Publication No. 2005/0048011.

In response, Applicants submit initially that subject matter of the present invention disclosed in the specification of US 2005/0048011, but not claimed in that reference, was derived from Ms. Eiko Kato, the inventor of the presently rejected claims. Accordingly, Applicants submit herewith a Declaration under 37 C.F.R. 1.132 in this regard, and further submit that this subject matter was not invented "by another" as required by 35 U.S.C. 102(e), such that Kato et al is not prior art to the present invention with respect to this subject matter.

Further, Applicants submit that particular disclosure in Kato relied upon by the Examiner is not supported by U.S. Provisional Application No. 60/359,334. For instance, Applicants wish to point out that Kato examples 21, 23, 25, 26, 29, 31, 33, 34, 37, and 38 cited by the Examiner clearly come from U.S. Provisional Application No. 60/373,579, which was filed on April 19, 2002.

In contrast, Applicants submit that the present application is entitled to benefit of the March 12, 2002 filing date of U.S. Provisional Application No. 60/363,102.

Since the Examiner relies on Kato examples 21, 23, 25, 26, 29, 31, 33, 34, 37, and 38 in her rejection of the present invention, and since Kato examples 21, 23, 25, 26, 29, 31, 33, 34, 37, and 38 clearly come from U.S. Provisional Application No. 60/373,579, which was filed on April 19, 2002, Applicants submit that the claimed invention antedates the cited art with respect to the disclosure in the cited art which is not supported by U.S. Provisional Application No. 60/359,334, whereby such disclosure in Kato cannot be used to reject the claimed invention.

In view of the above, reconsideration and withdrawal of the anticipation rejection over Kato is respectfully requested.

#### **Obviousness Rejection over Kato**

On page 4 of the Office Action, claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being obvious over Kato et al. US Publication No. 2005/0048011.

In response, Applicants refer the Examiner to discussion set forth above with respect to the anticipation rejection and submit that Kato et al is not prior art to the present invention.

Accordingly, Applicants submit that the present invention is not obvious over Kato, and withdrawal of this rejection is respectfully requested.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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WASHINGTON OFFICE

**23373**

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